

REMARKS

Claims 2-9 and 20-23 are pending in this application. Claims 1 and 10-19 have been canceled. Claims 20-23 have been added.

Foreign Priority

The indication that the foreign priority documents have been received and placed in the file is noted.

Information Disclosure Statement

The indication that the documents on an Information Disclosure Statement were fully considered is noted.

Restriction Requirement

Non-elected claims 10-19 have been cancelled without prejudice or disclaimer of the subject matter therein. The Applicants reserve their right to file a divisional application directed to the claims cancelled.

Specification

In section one of the Office Action, it was requested that the specification be reviewed for any minor errors. The specification has been reviewed and a minor editorial change has been made to page 1.

In section two of the Office Action it was requested that a new Title be supplied. A new Title has been submitted.

The Examiner is requested to reconsider and withdraw the objections to the specification.

Reply to Rejections

First Rejection:

Claims 2-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hasegawa, et al. (U.S. Patent 5,515,154). This rejection is traversed.

The details of this rejection were set forth in section 5 of the Office Action. In explaining the rejection with respect to the control means and its function which reads "the control means being so configured that an acting point of impacting force, which is generated in between the image carrier and the peripheral rotary body at a time of image formation, is located on an axis of the image carrier between a position of an axial end portion nearby in which the image carrier is supported" the Examiner relies on col. 7, lines 8-26 and Figure 3. Column 7, lines 18-26 states as follows:

"In this embodiment, the photosensitive drum 3 and the transfer drum 9 are positioned by abutting a pair of photosensitive drum rollers 33 rotatably mounted on a drum shaft on both sides of the photosensitive drum against a pair of transfer drum rollers 93 rotatably mounted on a drum shaft on both sides of the transfer drum. In this case, when the rollers 33 are abutted against the rollers 93, a gap of about 50 μ m is

created between the photosensitive drum 3 and the transfer drum 9."

The portion quoted in base claim 2 is set forth, for example, in the specification on page 32, first full paragraph. Also, a further explanation is set forth with respect to Figure 5b as explained, for example, on page 34, first full paragraph to page 35, line 2. A review of the portion relied on in the rejection as noted above does not either specifically or inherently set forth the features of the quoted portion of claim 2.

It may be that the Examiner is asserting that this structure of the reference inherently performs the function, but a rejection under 35 U.S.C § 102 cannot be based on probability or possibility. See *Continental Can Co. USA. Inc. v Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) wherein the Court stated as follows:

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled... [such] that the missing... matter is necessarily present in the... reference, and that it would be so recognized by persons of ordinary skill... "Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient..." (citations omitted)

Thus the assertion of the structure that performs the function in the claims with respect to the reference is not viable. Accordingly, a rejection under 35 U.S.C. § 102 is also not viable.

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base claims.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102.

Second Rejection:

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hasegawa, et al. (U.S. Patent 5,515,154) in view of Yoshinaga, et al. (U.S. Patent 6,208,826). This claim has been cancelled and accordingly the rejection is moot.

Allowable Subject Matter

In section 10 of the Office Action, claims 6-9 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claims and any intervening claims.

Initially, claim 6 has been amended to include the structure of its base claim 2. Also, in claim 6, the phrase "each of the first and second--members" has been cancelled and amended. This has been done because there was no antecedent basis in claim 2 for the first and second control members.

Also, new claims 20-23 have been added as explained below.

New Claims

New claims 20-23 have been added.

Claim 20 is an independent claim including limitations of original claims 2, 4 and 6. This base claim should be considered allowable at least because it includes the structure of original claim 6 indicated allowable. Claims 21-23 are dependent on claim 20 and contain the structure of original claims 7, 8 and 9.

Additional Art

In section 11 of the Office Action, additional art was cited. As this art has not been applied, no further comments are considered necessary.

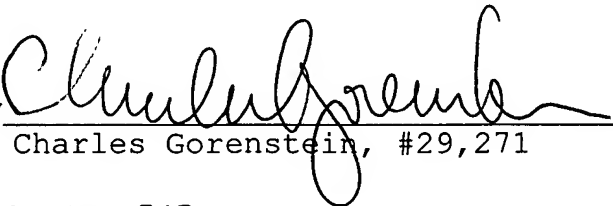
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot A. Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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